

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s):	J. Ronning & K. Wical	Conf. No.	1448
Serial No.:	09/492,844	Examiner:	Yogesh C. Garg
Filed:	January 27, 2000	Group Art Unit:	3625
Docket:	D33-029-03-US	Customer No.	54,092
Title:	Apparatus and Method for Secure Downloading of Files		

**REPLY BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir or Madam:

This Reply Brief is submitted in response to the Examiner's Answer dated November 23, 2007.

**I. Status Of Claims**

Claims 1, 3, 8, 14 – 16, 23, 25, 30, 36 – 38, 67 and 68 are pending in the application. The pending claims are presented in the Claims Appendix of this Brief. This appeal is taken for all of the pending claims 1, 3, 8, 14 – 16, 23, 25, 30, 36 – 38, 67 and 68 which stand rejected by the Examiner in the Final Office Action dated October 3, 2006 (hereafter the "Final Office Action").

**II. Grounds Of Rejection To Be Reviewed On Appeal**

Whether claims 1, 3, 8, 14-16, 23, 25, 30, 36 – 38 and 67 – 68 are unpatentable under 35 USC §103(a) over U.S. Patent 6,226,618 by Downs et al. (Downs '618) in view of U.S. Patent 5,652,786 by Rogers (Rogers '786).

### III. Argument

For the sake of brevity the arguments presented in the previously filed Appeal Brief are not repeated below; however, those arguments are still valid in view of the Examiner's Answer. As such those arguments are incorporated by reference herein and still presented to the Appeal Board.

It is rather curious that the Examiner has chosen the Examiner's Answer for the first time in over seven years of pendency before him to state a case of obviousness to the Applicant and actually identify what he believes is taught by each reference. At the same time, the Examiner has been careful not to identify this first time presented case of obviousness as a new ground for rejection that would permit reopening prosecution of this application. Unfortunately, this means the Applicant must continue this appeal and potentially waste the Appeal Board's time.

#### A. **Failed To Present Prima Facie Case of Obviousness**

Even in this new ground for rejection under obviousness, the Examiner still has not established a *prima facie* case of obviousness under 35 U.S.C. §103(a). As noted in the Appeal Brief, a *prima facie* case of obviousness must include three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). See also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In presenting the new ground for rejection, the Examiner continues to assert that that all of the elements of claims 1, 3, 8, 16, 23, 25, 30, 36 – 38 and 67 – 68 are taught by Downs '618, but not the limitation of "selectively permitting the download of the file based upon a number of attempted downloads of the file by the user." (See Examiner's Answer, first paragraph on page 14. The Examiner asserts that Rogers '786 teaches this feature described in claims 1 and 23.

When describing the features taught by Downs '618, the Examiner is quick to point out that an order identifier is verified by Clearinghouse 105. Applicant does not dispute this statement, but such a statement does not go far enough. The Examiner has gone to some lengths to describe order verification procedures taught by Downs '618 (See Examiner's Answer, pages 10-14. The Examiner's arguments still fail to describe where Downs '618 teaches verification of the order identifier based upon particular information as claimed in claims 1 and 23. The reason for this failing is obvious, as previously stated in the Appeal Brief by the Applicant (see Appeal Brief, page 7), Downs '618 is not capable of doing verifications of the type claimed by the Applicant due to the download system configuration. Due to this system configuration, Downs '618 simply does not teach the specific order identifier verification as described in pending claims 1 and 23. Specifically, the download system taught by Downs '618 fails to describe the feature of verifying the order identifier based upon particular information related to the order, including: (1) determining if the order identifier is valid for the order, meaning the order identifier exists for the order, (2) determining if the order identifier is active, meaning the order was not canceled before the download of the file, and (3) determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file.

In addition, the Examiner disagrees with the Applicant's arguments presented on pages 7-8 of the Appeal Brief that Downs '618 fails to describe the feature in pending claims 1 and 23 of "selectively permitting the download of the file to the end user machine based upon ... a number of attempted downloads of the file by the user". The Examiner goes onto state that Downs '618 stores a count of download attempts by a user and uniquely identifies a user and then points to column 70, lines 4-13 as teaching this feature. However, at column 70, lines 4-13 Downs '618 actually describes something else entirely. It actually states that a database is checked to see if a License SC ID 660 has ever been used before and if so blocks a download of Content 113. This License SC ID is not unique to a particular user, but rather to a particular sales transaction involving specific Content SC 630. Downs '618 never describes receiving anything that could uniquely identify an end user or end user machine. Thus, Downs '618 does not

describe any facility for storing information about download transactions so that they can be compared to future download requests from a specific end user.

Further, claims 1 and 23 claim "selectively permitting the download of the file to the end user machine based upon ... a number of attempted downloads of the file by the user". The phrase "a number of attempted downloads" refers to more than one download by the same user. Downs '618 does not anticipate a need to permit more than one download attempt (see column 70, lines 4-13 Downs '618). Upon careful review of Downs '618, it should be noted that Downs '618 actually teaches away from such a system that permits multiple downloads. Downs '618 at column 70, line 11 actually prevents repeated access by an End-User Device 109.

Thus, the Applicant still has not been provided a prima facie case of obviousness which it could rebut and all four factual inquiries could not be completed as contemplated by Graham v. John Deere. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). As such, this obviousness rejection is flawed and must be overturned by the Board.

#### **B. Other Considerations – KSR International and TSM test**

In the past one method used to resolve the obviousness question with more uniformity and consistency has been the employment of a teaching, suggestion, or motivation (TSM) test, under which a patent claim is only proved obvious if the prior art, the problem's nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings. KSR International v. Teleflex Inc., 550 U.S. \_\_\_ (2007). Although this test was not explicitly overturned in KSR International v. Teleflex Inc., the Court pointed out that the correct analysis involves applying common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle. Id. In the present situation, the Applicant need not apply either of these analytical tests to the obviousness question. This is because, as described previously, no prima facie case of obviousness has been made in the Final Office Action.

Even with the new grounds for rejection given in the Examiner's Answer and if an application of common sense combinations of the Downs '618 and Rogers '786 references were made by one of ordinary skill in the art at the time the present invention was made, these combinations would not have resulted in the invention as claimed in independent claims 1 and 23. In particular, neither reference teaches or suggests having a communication between an electronic store that generates an order identifier and a content hosting site that permits downloading of content. This communication is an essential part of a verification process involving that order identifier prior to permitting downloading of the content. In addition, neither reference teaches or suggests having the content hosting site keep a historical record of transactions linked to a user. This historical record is an essential part of a verification process involving checking that historical record for the number of attempts of the same file by the same user.

With respect to the remaining dependent claims, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 3, 8, 14-16, and 67 depend from claim 1 and therefore are allowable over Downs '618 and Rogers '786 for the same reasons that claim 1 is allowable. Claims 25, 30, 36-38, and 68 depend from claim 23 and therefore are allowable over Downs '618 and Rogers '786 for the same reasons that claim 23 is allowable. Furthermore, as previously noted claims 3, 8, 16, 25, 30, 38, 67 and 68 recite additional features that independently render them patentable over Downs '618 and Rogers '786.

For example, Downs '618 also fails to teach, describe, or even suggest the permitting step further includes permitting download of the file based upon the verification of the transaction identifier, as described in the language of the pending dependent claims 8 and 30. The Examiner has pointed to passages in Downs '618 that verify a transaction identifier when creating a License SC 660 which happens before, but not at the time of permitting download of a file as presently claimed.

Similarly, Downs '618 also fails to teach, describe, or even suggest denying the download of the file based upon a customer identifier associated with the user, as described in the language of the pending dependent claims 16 and 38. The Examiner

has pointed to passages in Downs '618 that verify an end user's device when creating a License SC 660 which happens before, but not at the time of permitting download of a file as presently claimed.

Finally, Downs '618 also fails to teach, describe, or even suggest permitting download of the file based upon a number of successful downloads of the file by the user, as described in the language of the pending dependent claims 67 and 68. The phrase "a number of successful downloads of the file by the user" refers to more than one successful download by the same user. As previously discussed, Downs '618 does not anticipate a need to permit more than one download attempt (see column 70, lines 4-13 Downs '618) and actually teaches away from such a system by preventing any repeated access by an End-User Device 109 to a piece of Content 113. Thus, Downs '618 does not teach or suggest the features claimed in pending dependent claims 67 and 68.

Therefore, under 35 USC §103(a) Downs '618 and Rogers '786 fail to teach the present invention as claimed in claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67 and 68 and a withdrawal of this objection is respectfully requested.

#### **IV. Conclusion**

On the basis of the foregoing, Applicant respectfully submits that all of the rejections made in the Final Office Action should be overturned and claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 should be passed to issuance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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